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09/715,641	11/17/2000	Robert D. Haskins	ZIP00-01	7793

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EXAMINER

DENNISON, JERRY B

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 03/29/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

22

Office Action Summary

Application No.

09/715,641

Applicant(s)

HASKINS ET AL.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This Action is in response to Application Number 09/715641 received on 17 November 2000.
2. Claims 1-28 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 2 recites the limitation "quota enforcement function" in line 17 of page 35. There is insufficient antecedent basis for this limitation in the claim. Examiner will interpret the limitation as "quota enforcement operation." Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 11-22, and 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Mow (U.S. Patent Number 6,668,045) hereinafter referred to by Mow.

5. Regarding claims 1, 12, 14, and 26-28, Mow discloses a system and method for controlling transmission of messages from an originator computer system, comprising:

a processor, memory system, and network interface (col. 3, lines 20-30 and Fig. 4B, Mow teaches a computerized system connected to the Internet);

detecting an outbound message from an originator computer system (Fig. 4B, Mow teaches an inmate preparing an email to an external party, the system detecting the email and performing actions);

performing a quota enforcement operation based on a message count and a message limit to produce a message transmission result (Fig 4B, Mow teaches an Activity Guard which limits the quantity of messages from the inmate); and

performing a selective transmit operation including at least one of

i) transmitting the outbound message onto a computer network if the message transmission result contains a transmit value (Fig. 4B, Mow teaches sending the email); and

ii) preventing transmission of the outbound message onto a computer network if the message transmission result contains a no transmit value (Fig. 4B, and col. 3, line 54-55, Mow teaches that if the inmate exceeds the message count, the message communications will not be allowed).

6. Regarding claim 2, Mow discloses the features of the invention, substantially as claimed, as described in claim 1, including wherein the step of performing the quota enforcement function includes the steps of comparing the message count associated with an originator identity of the outbound message with the message limit assigned to the originator identity of the outbound message to determine an occurrence of a message limit condition, and if the message limit condition occurs, setting the message transmission result to a no-transmit value, and if the message limit condition does not occur, setting the message transmission result to a transmit value and updating the message count associated with the originator identity of the outbound message (col. 3, lines 50-56, Mow teaches that each inmate of the system has a PIN number, and a message count keeping track of the number of messages sent by each PIN number).

7. Regarding claim 3, Mow discloses the features of the invention, substantially as claimed, as described in claim 2, including wherein the step of comparing the message count associated with an originator identity of the outbound message includes the steps of.

obtaining an originator address associated with the outbound message (col. 3, lines 35-45, Mow teaches that each inmate has a personal identification number and/or email address);

obtaining the originator identity associated with the outbound message by performing an originator identity lookup based on the originator address (col. 3, lines 35-55, Mow teaches inmates represented by PIN numbers/email addresses); and

obtaining at least one message count associated with the originator identity by performing a message count lookup based on the originator identity (col. 3, lines 50-55, Mow teaches a message count associated with each inmate's PIN number).

8. Regarding claim 4, Mow discloses the features of the invention, substantially as claimed, as described in claim 3, including wherein:

the step of obtaining an originator address includes retrieving a network address associated with the outbound message from a message connection establishment protocol used to transfer the outbound message from an originator computer system to a recipient computer system (col. 3, lines 35-50);

the step of obtaining the originator identity includes the step of querying a login database containing mappings of originator addresses to originator identities based on the originator address obtained in the step of obtaining an originator address (Fig. 5, 240, Mow teaches a database of Allowed Call, PIN, email lists); and the

step of obtaining a message count for the originator identity associated with the outbound message includes querying a quota database containing associations of message counts to originator identities based on the originator identity associated with the outbound message (Fig. 5 14, 160, 170, 210, and 220, Mow teaches money balances and billing for outbound messages); and

wherein the message count is at least one message count that indicates, for an

originator identity, a current number of outbound message transmitted over an elapsed time interval (col. 3, lines 35-50, Mow teaches a message count of the number of messages transmitted over a period of time); and

wherein the message limit is at least one message limit corresponding to a respective at least one message count that indicates, for an originator identity, a maximum number of outbound messages that may be transmitted over a predetermine time interval (col. 3, lines 35-50, Mow teaches a certain message quantity within a certain time frame).

9. Regarding claim 5, Mow discloses the features of the invention, substantially as claimed, as described in claim 2, including wherein the step of updating the message count associated with the originator identity of the outbound message includes the steps of calculating a total number of recipients for the outbound message and incrementing the message count associated with the originator identity by the total number of recipients for the outbound message (col. 4, lines 25-30, Mow teaches the charge for each message being subtracted from a previously established account balance for the inmate's PIN, meaning that every message being sent is counted in the message count).

10. Regarding claim 6, Mow discloses the features of the invention, substantially as claimed, as described in claim 2, including wherein the message limit indicates an amount of outbound messages that may be transmitted from the originator computer

system over a certain period of time for the originator identity associated with the outbound message (col. 3, lines 35-50); and

wherein the originator identity of the outbound message is indicative of a specific user account operating under control of a computer user (col. 35-50, Mow teaches a PIN/email for each inmate);

11. Regarding claim 7, Mow discloses the features of the invention, substantially as claimed, as described in claim 2, including wherein:

the message limit condition indicates if a computer user account associated with the originator identity used to transmit the outbound message is attempting to transmit a number of outbound messages that exceeds the message limit in a predetermined amount of time (Fig. 4B and col. 3, lines 35-50); and

wherein the message limit condition occurs if the step of comparing determines at least one of the message count exceeds the message limit (Fig. 4B and col. 3, lines 35-50);; and

the message count is equal to the message limit (Fig. 4B and col. 3, lines 35-50);.

12. Regarding claims 8 and 21, Mow discloses the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein the quota enforcement operation includes the steps of:

verifying an authenticity of an originator address associated with the outbound message and verifying authenticity of at least one recipient associated with outbound message (col. 3, lines 39-44, Mow teaches a system that screens messages using an

“allowed call list” of email addresses that the inmate may send and/or receive messages).

13. Regarding claims 9 and 22, Mow discloses the features of the invention, substantially as claimed, as described in claims 1 and 14, including wherein the step of performing a quota enforcement operation includes the step of:

comparing a previous message transmission result with a no-transmit value, and if the previous message transmission decision equals the no-transmit value, performing the step of performing a selective transmit operation (col. 3, lines 50-55, Mow teaches an activity guard process, if the message count exceeds a limit, the message is not transmitted).

14. Regarding claim 11, Mow discloses the features of the invention, substantially as claimed, as described in claim 1, including the steps of:

authenticating a connection from the originator computer system (col.3 ,lines 35-50, Mow teaches clients using PIN numbers to authenticate connection with the system);

recording authentication information in a login database, the authentication information including an originator address assigned to the originator computer system and an originator identity associated with the originator address (Fig. 4B);

receiving, for transmission to a recipient computer system, the outbound message from the originator computer system (Fig. 4B);

forwarding the outbound message to a quota server to perform the steps of

detecting an outbound message, performing a quota enforcement operation and performing a selective transmit operation (Fig. 4B).

15. Regarding claim 13, Mow discloses the features of the invention, substantially as claimed, as described in claim 12, including wherein:

the at least one message count includes a first message count and a second message count (col. 3, lines 35-50, Mow teaches a message count for each user);

wherein the at least one message limit includes a first message limit and a second message limit (col. 3, lines 35-50, Mow teaches a limit for each user);

wherein in the step of comparing, the first message count is compared to the first message limit to determine if the first message count exceeds the first message limit in which case the message transmission result is set to a no-transmit value (col. 3, lines 35-50, Mow teaches comparing each user's message count to a limit); and

wherein in the step of comparing, the second message count is compared to the second message limit to determine if the second message count exceeds the second message limit in which case the message transmission result is set to a no-transmit value (col. 3, lines 35-50, Mow teaches comparing each user's message count to a limit).

16. Regarding claim 15, Mow discloses the features of the invention, substantially as claimed, as described in claim 14, including wherein when the processor performs the operation of performing the quota enforcement function, the processor causes the computer system to perform the operations of comparing the message count associated

with an originator identity of the outbound message with the message limit assigned to the originator identity of the outbound message to determine an occurrence of a message limit condition, and if the message limit condition occurs, setting the message transmission result to a no-transmit value, and if the message limit condition does not occur, setting the message transmission result to a transmit value (col. 3, lines 35-50); and

updating the message count associated with the originator identity of the outbound message (col. 3, lines 35-50).

17. Regarding claim 16, Mow discloses the features of the invention, substantially as claimed, as described in claim 15, including wherein when the processor performs the operation of comparing the message count associated with an originator identity of the outbound message, the processor causes the computer system to perform the operations of obtaining an originator address associated with the outbound message detected at the interface (col. 3, lines 35-50);

obtaining the originator identity associated with the outbound message by performing an originator identity lookup in a login database coupled to the computer system based on the originator address (col. 3, lines 35-50, Fig 4B), and

obtaining at least one message count associated with the originator identity by performing a message count lookup in the quota database based on the originator identity (col. 3, lines 35-50).

18. Regarding claim 17, Mow discloses the features of the invention, substantially as claimed, as described in claim 16, including wherein, when performed by the processor the operation of obtaining an originator address includes retrieving a network address associated with the outbound message from a message connection establishment protocol used to transfer the outbound message from an originator computer system to a recipient computer system (col. 3, lines 35-50, Mow teaches the system sending messages through email, which involves retrieving a networks address using a protocol);

the operation of obtaining the originator identity includes the querying a login database containing mappings of originator addresses to originator identities based on the originator address obtained in the operation of obtaining an originator address (col. 3, lines 35-50 and Fig 4B, Mow teaches a database of PIN numbers/ emails for each user); and

the operation of obtaining a message count for the originator identity associated with the outbound message includes querying a quota database containing associations of message counts to originator identities based on the originator identity associated with the outbound message(col. 3, lines 35-50 col. 4, lines 25-35, and Fig 4B, Mow teaches charging for each message per user, every time a user sends a message, the system must check the user's limit); and

wherein the message count is at least one message count that indicates, for an originator identity, a current number of outbound message transmitted over an elapsed time interval (col. 3, lines 35-50); and

wherein the message limit is at least one message limit corresponding to a respective at least one message count that indicates, for an originator identity, a maximum number of outbound messages that may be transmitted over a predetermine time interval (col. 3, lines 35-50).

19. Regarding claim 18, Mow discloses the features of the invention, substantially as claimed, as described in claim 15, including wherein when the processor performs the operations of updating the message count associated with the originator identity of the outbound message, the processor further performs the operations of:

calculating a total number of recipients for the outbound message (col. 3, lines 35-50 and col. 4, lines 25-35 Mow teaches charging for each message sent out from the user); and

incrementing the message count associated with the originator identity in the quota database by the total number of recipients for the outbound message (col. 3, lines 35-50).

20. Regarding claim 19, Mow discloses the features of the invention, substantially as claimed, as described in claim 15, including wherein:

the message limit indicates an amount of outbound messages that may be transmitted from the originator computer system over a certain period of time for the originator identity associated with the outbound message (col. 3, lines 35-50); and

wherein the originator identity of the outbound message is indicative of a specific user account operating under control of a computer user (col. 3 ,lines 35-50, Mow teaches each user having an account or PIN);

21. Regarding claim 20, Mow discloses the features of the invention, substantially as claimed, as described in claim 15, including wherein:

the message limit condition indicates if a computer user account associated with the originator identity used to transmit the outbound message is attempting to transmit a number of outbound messages that exceeds the message limit in a predetermined amount of time(col. 3 ,lines 35-50); and

wherein the message limit condition occurs if the processor, when performing the operation of comparing, determines at least one of the message count exceeds the message limit (col. 3 ,lines 35-50); and
the message count is equal to the message limit (col. 3 ,lines 35-50).

22. Regarding claim 24, Mow discloses the features of the invention, substantially as claimed, as described in claim 14, including:

a remote access server coupled to the receive a connection from the originator computer system (col. 3, lines 35-50 and Fig 4B);

an authentication server coupled to the remote access server, the authentication server authenticating a connection from the originator computer system when the connection is received by the remote access server, the authentication server including a login extractor that records authentication information in a login database, the

authentication information including an originator address assigned to the originator computer system and an originator identity associated with the originator address; a port redirector coupled to the remote access server, the port redirector receiving, for transmission to a recipient computer system, the outbound message via the connection from the originator computer system and forwarding the outbound message to the interface for receipt by the quota server which, when performed on the processor, causes the processor to perform the operations of detecting an outbound message, performing a quota enforcement operation and performing a selective transmit operation (col. 3, lines 35-50 and Fig 4B).

23. Regarding claim 25, Mow discloses the features of the invention, substantially as claimed, as described in claim 24, including wherein the port redirector is a data communications device capable of directing outbound messages based on content contained within the outbound message, and wherein when the port redirector receives an outbound message that is to be subject to message quota enforcement based upon content contained with the outbound message,, the port redirector forwards the outbound message to the quota server (col. 3, lines 35-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mow in view of obviousness.

24. Regarding claims 10 and 23, Mow teaches the limitation of claims 1 and 14. Mow also teaches each user having a unique PIN, which allows access to using email services, the PIN mainly tracking the number of messages sent by the user. Mow does not disclose wherein the step of detecting an outbound message includes the steps of:

searching a quota enforcement list for an originator address associated with the message, and if the originator address associated with the message is contained in the quota enforcement list, performing the steps of performing a quota enforcement operation and performing a selective transmit operation, and if the originator address associated with the message is not contained in the quota enforcement list, skipping the step of performing the quota enforcement operation and performing the step of transmitting the outbound message from the computer system.

However, it would have been obvious to one in the ordinary skill in the art at the time the invention was made to include addresses without performing a quota enforcement operation or a selective transmit operation for the benefit of allowing system administrators to update and use the system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (703) 305-8756. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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